

PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q78706

Tadahiho KEGASAWA, et al.

Appln. No.: 10/725,053

Group Art Unit: 1791

Confirmation No.: 2949

Examiner: Jeffrey Michael WOLLSCHLAGER

Filed: December 2, 2003

For: METHOD AND APPARATUS FOR FORMING RESIN FILM

SUBMISSION OF APPEAL BRIEF

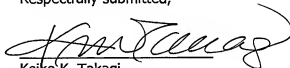
MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith please find an Appeal Brief. The USPTO is directed and authorized to charge the statutory fee of \$540.00 and all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

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I. REAL PARTY IN INTEREST

The real party in interest is FUJIFILM Corporation.

II. RELATED APPEALS AND INTERFERENCES

Appellants, Appellants' legal representative and the Assignee of this application are not aware of any other appeals or interferences that will directly affect, or be affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-5 are pending in the application. Claims 6-17 have been canceled.

Claims 1-5 are rejected.

This is an appeal from the Examiner's rejections of claims 1-5 under 35 U.S.C. § 103(a).

IV. STATUS OF AMENDMENTS

The Amendment under 37 C.F.R. § 1.116 submitted on August 26, 2008, is the last response submitted with amendments to the claims of the application. A Request for Continued Examination was filed on September 15, 2008 to force entry of the amendments.

There are no outstanding amendments to the claims or to the specification in the present application.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Independent claim 1 is directed to a method of forming a resin film from a first resin for a middle portion to form a resin film main body of the resin film and a second resin for edge portions to form both side edge portions in a crosswise direction of the resin film. *See* page 2, line 30 to page 3, line 2. The method comprising the steps of: joining the first resin and the second resin in such a manner as to enclose only both side edges in the crosswise direction of the first resin for the middle portion which is formed as a cross-section convex shape with the second resin for the edge portions which is formed as a cross-section concave shape and to form a boundary of the first resin and the second resin (*see* Fig. 4); and extruding the joined resins through an extruding die to form the resin film. *See* page 3, lines 2-11 and page 8, line 30 to page 9, line 4. The first and second resins are joined by being fed through a feed block (*see* Fig. 3) which includes a joining part having a specific cross-sectional shape in such a manner as to enclose only both side edges in the crosswise direction of the resin film main body which is formed as a cross-section convex shape with the resin for the edge portions which is formed as a cross-section concave shape. *See* page 5, lines 29-32 and page 8, lines 28-30.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

An issue on appeal is whether the Examiner improperly finally rejected claims 1-5 under 35 U.S.C. §103(a) as allegedly being unpatentable over Wentz Jr. (US 4,731,004).

An issue on appeal is whether the Examiner improperly finally rejected claims 1, 2 and 4 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Peiffer et al. (US 5,716,570) in view of Wenz Jr. (US 4,731,004).

An issue on appeal is whether the Examiner improperly finally rejected claims 1, 3, and 4 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hoagland et al. (US 3,825,383) in view of Peiffer et al. (US 5,716,570).

VII. ARGUMENT

- A. The rejection of claims 1-5 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Wenz Jr. (US 4,731,004) should be reversed because a *prima facie* case of obviousness has not been established.**

A *prima facie* showing of obviousness requires (1) a suggestion or motivation in the references or in the knowledge of one of ordinary skill in the art, to modify the references or to combine reference teachings; (2) a reasonable expectation of success; and (3) a teaching or suggestion of all claimed limitations.

It is respectfully submitted that Wenz Jr. does not teach or suggest every element of claim 1.

Claim 1 is directed to a method of forming a resin film from a first resin for a middle portion to form a resin film main body of the resin film and a second resin for edge portions to form both side edge portions in a crosswise direction of the resin film, the method comprising the steps of: joining the first resin and the second resin in such a manner as to enclose only both side edges in the crosswise direction of the first resin for the middle portion which is formed as a cross-section convex shape with the second resin for the edge portions which is formed as a cross-section concave shape and to form a boundary of the first resin and the second resin; and extruding the joined resins through an extruding die to form the resin film. The first and second resins are joined by being fed through a feed block which includes a joining part having a specific cross-sectional shape in such a manner as to enclose only both side edges in the crosswise direction of the resin film main body which is formed as a cross-section convex shape with the resin for the edge portions which is formed as a cross-section concave shape.

It is respectfully submitted that Wenz Jr. fails to teach or suggest "joining the first resin and the second resin in such a manner as to enclose only both side edges in the crosswise direction of the first resin for the middle portion which is formed as a cross-section convex shape with the second resin for the edge portions which is formed as a cross-section concave shape and to form a boundary of the first resin and the second resin" as recited in claim 1.

Claim 1 specifically recites that the joining part have a specific cross-sectional shape so that the main body is formed as a convex shape and the edge portions are formed as a concave shape. For example, claim 1 specifically requires a cross-sectional configuration such as that set forth in Figs. 3 and 4. Wenz Jr. does not teach or suggest the claimed feed block used to join the first and second resins. In addition, Wenz Jr. fails to disclose a structure that would result in the claimed concave/convex shape between the first and second resins.

Further, it is respectfully submitted that Wenz Jr. does not teach or suggest the manner in which the edges of the second resin are enclosed by the first resin to form a boundary. The Examiner refers to Fig. 4 of Wenz Jr. and asserts that the teaching of Wenz Jr. clearly suggests/implies splitting the streams up with barriers in a variety of manners to achieve a desired film. The Examiner also submits the control of the taper and fade set forth in Wenz Jr. clearly suggests the argued limitation (col. 3, lines 21-29 and 43-51; col. 6, lines 36-53).

Appellants respectfully disagree.

Although Fig. 4 of Wenz Jr. shows resin A/resin B/resin A, it clearly shows commingling or intermixing of resins A and B. Thus, Fig. 4 does not support the Examiner's position that Wenz Jr. discloses resin A as "enclosing" the side edges of resin B.

In addition, the recitation "boundary" means that there is no overlap or intermixing of

the resins and the concave/convex structure is a result of the use of the joining part having a specific shape. In contrast, Wenz Jr. discloses intermixing or overlap between the resins, which is the opposite of there being a boundary.

Furthermore, the disclosure relied upon by the Examiner at column 3, lines 21-29 does not support the Examiner's position. This disclosure states that if little or no overlap or intermix is desired, the barrier is generally extended along the entire length of the entry manifold. The barrier is, for example, depicted in Figs. 3 and 4 as reference number 24 of Wenz Jr.

In this regard, there is no teaching or suggestion in Wenz Jr. that the barrier has a structure that would allow resin A to enclose resin B or result in a concave/convex structure. That is, Wenz Jr. discloses that the shape of the barrier will influence the degree of overlap or intermix, but does not teach that the shape of the barrier affects the shape of the overlap such that it results in a concave/convex shape.

Moreover, the "taper, fade, overlap and intermix" of Wenz Jr. clearly is different from the present invention. Wenz Jr. discloses that the taper or fade out of the opaque material into the clear material. This suggests that there is overlap between the first and second resins and the disclosure is related to the control of the overlap, whereas in the claimed invention there is no overlap.

For at least the above reasons, it is respectfully submitted that Wenz Jr. does not disclose joining the first resin and the second resin in such a manner as to enclose only both side edges in the crosswise direction of the first resin for the middle portion which is formed as a cross-section convex shape with the second resin for the edge portions which is formed as a cross-section concave shape or the joining part, as recited in claim 1.

Accordingly, it is respectfully submitted that claims 1-5 are patentable over Wenz Jr.

B. The rejection of claims 1-5 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Peiffer et al. (US 5,716,570) in view of Wenz Jr. (US 4,731,004) should be reversed because a *prima facie* case of obviousness has not been established.

As noted above, a *prima facie* showing of obviousness requires a teaching or suggestion of all claimed limitations.

It is respectfully submitted that Peiffer and Wenz Jr. fail to teach or suggest every element of claim 1.

The Examiner acknowledges that Peiffer does not teach that the main resin has a convex shape and the side edge resin has a concave shape. To cure the deficiencies, the Examiner relies on Wenz Jr. as teaching a method of side-by-side co-extrusion to form a film where the shape of the interface between the resins is controlled and adjusted as required to achieve a desired appearance. The Examiner takes the position that it would have been obvious to one of ordinary skill in the art to modify Peiffer to optimize the shape of the interface between the resins.

Appellants respectfully disagree.

It is respectfully submitted that Peiffer does not disclose joining polymer B and polymer A in a manner such that both side edges of polymer B are enclosed by polymer A. In addition, Peiffer does not specifically disclose or mention the shape of the cross-section where the polymer B and polymer A are joined. Further, based on, for example, Fig. 3 of Peiffer, the polymer A does not enclose polymer B.

Moreover, for the reasons discussed above, Wenz Jr. does not cure the deficiencies of Peiffer. Accordingly, even if the references were somehow combined, the combination would not result in the present invention of claim 1.

For at least the above reasons, it is respectfully submitted that the present invention is not taught or suggested by the cited references, and that claims 1-5 are patentable.

C. The rejection of claims 1, 3, and 4 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hoagland et al. (US 3,825,383) in view of Peiffer et al. should be reversed because a *prima facie* case of obviousness has not been established.

As noted above, a *prima facie* showing of obviousness requires a teaching or suggestion of all claimed limitations.

It is respectfully submitted that Hoagland and Peiffer fail to teach or suggest every element of claim 1.

As noted above, claim 1 recites "joining the first resin and the second resin in such a manner as to enclose **only** both side edges in the crosswise direction of the first resin for the middle portion which is formed as a cross-section convex shape with the second resin for the edge portions which is formed as a cross-section concave shape".

In contrast, Hoagland teaches forming a multi-layered film where a first resin and second resin are extruded as layers, and for example, the second resin is formed on the main body surfaces of the first resin. Thus, Hoagland does not disclose enclosing only both side edges in the crosswise direction of the first resin.

In addition, as discussed above, Peiffer does not disclose that polymer B and polymer A are joined in a manner such that both side edges of polymer B are enclosed

by polymer A. Peiffer also does not specifically disclose or mention the shape of the cross-section where the polymer B and polymer A are joined. Thus, Peiffer does not cure the deficiencies of Hoagland.

Accordingly, even if Hoagland and Peiffer were somehow combined, the combination would not result in the present invention of claim 1.

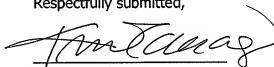
For at least the above reasons, it is respectfully submitted that claims 1, 3 and 4 are patentable over the cited art.

Conclusion

For at least the above reasons, Appellants respectfully submit that the obviousness rejections should be reversed.

The USPTO is directed and authorized to charge the statutory fee (37 C.F.R. §41.37(a) and 1.17(c)) and all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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Date: June 25, 2009

CLAIMS APPENDIX

CLAIMS 1-5 ON APPEAL:

1. A method of forming a resin film from a first resin for a middle portion to form a resin film main body of the resin film and a second resin for edge portions to form both side edge portions in a crosswise direction of the resin film, the method comprising the steps of:

joining the first resin and the second resin in such a manner as to enclose only both side edges in the crosswise direction of the first resin for the middle portion which is formed as a cross-section convex shape with the second resin for the edge portions which is formed as a cross-section concave shape and to form a boundary of the first resin and the second resin; and

extruding the joined resins through an extruding die to form the resin film,

wherein the first and second resins are joined by being fed through a feed block which includes a joining part having a specific cross-sectional shape in such a manner as to enclose only both side edges in the crosswise direction of the resin film main body which is formed as a cross-section convex shape with the resin for the edge portions which is formed as a cross-section concave shape.

2. The method as defined in claim 1, wherein a degree of enclosing the first resin for the middle portion with the second resin for the edge portions is adjusted according to a difference in melt flow rate between the resins.

3. The method as defined in claim 1, wherein a degree of enclosing the first resin for the middle portion with the second resin for the edge portions is adjusted according to a difference in extrusion rate between the resins.

4. The method as defined in claim 1, wherein a degree of enclosing the first resin for the middle portion with the second resin for the edge portions is adjusted according to a difference in resin temperature between the resins.

5. The method as defined in claim 1, wherein a degree of enclosing the first resin for the middle portion with the second resin for the edge portions is adjusted according to a width of the resin film.

EVIDENCE APPENDIX:

Pursuant to 37 C.F.R. § 41.37(c)(1)(ix), submitted herewith are copies of any evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 or any other evidence entered by the Examiner and relied upon by Appellant in the appeal.

None.

RELATED PROCEEDINGS APPENDIX

Submitted herewith are copies of decisions rendered by a court or the Board in any proceeding identified about in Section II pursuant to 37 C.F.R. § 41.37(c)(1)(ii).

None.